

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: TRIBBLE, Ron

Docket No.: NETS0044

Serial No.: 09/668,125

Art Unit: 3626

Filed: 09/21/2000

Examiner: Frenel, Vanel

Title: BUSINESS RULES SYSTEM

March 30, 2007

Mail Stop – Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE BOARD
OF APPEALS AND INTERFERENCES**

REPLY BRIEF (37 CFR 41.41 (a)(1) and 41.43(b))

This Reply Brief is submitted pursuant to an appeal from the Primary Examiner of Group Art Unit 3626 refusing Claims 1-4, 6-11, 13-18, 20 and 21 of the above-identified patent application.

The Commissioner is authorized to charge any additional fees or credit any overpayments to Glenn Patent Group Deposit Account 07-1445, Customer No. 22, 862 (Order No. NETS0044).

STATUS OF CLAIMS

The application was originally filed with Claims 1-21. Claims 5, 12, and 19 have been canceled. Therefore, Claims 1-4, 6-11, 13-18, 20, and 21 are pending in the application.

Claims 1-4, 6-11, 13-18, 20, and 21 stand rejected; these claims are being appealed.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-4, 6-11, 13-18, 20, and 21 were rejected under 35 USC 103 as being unpatentable over USPN 5,400,248 (Chisholm) in view of USPN 4,210,962 (Marsh).

The foregoing rejections were made in the non-final Office Action, dated 8/27/04. These rejections have been maintained in the final Office Action, dated 2/10/05.

ARGUMENT AND DISCUSSION

Applicant herewith responds to the Examiner's answer in the above identified appeal.

In Applicant's brief, Applicant pointed out that the Examiner has failed to make a *prima-facie* showing of obviousness. Responsive thereto, the Examiner has cited a few cases (page 7) (i), and stated he has "satisfied the burden of presenting a *prima-facie* case of obviousness." Other than these bald

assertions, the Examiner has not provided any evidence in support of these statements, nor has the Examiner in any way answered the allegations of error made in Applicant's brief with a substantive analysis. For example, the Examiner's explanation of satisfying the burden is that "he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combination that fairly suggest Appellant's claimed invention." However, Applicant has specifically pointed out in its brief the basis upon which the Examiner makes his analysis is erroneous. The Examiner has not addressed Applicant's charges of error, but has simply stated that he has made the argument and that should be sufficient.

Further, the Examiner freely exchanges the requirement for identifying the claim elements in the prior art with the notion of motivation to make a combination. For example, the Examiner states "that each and every motivation to combine the applied references are accompanied by select portions of the respective reference(s) which specifically support that particular motivation and/or an explanation based on logic and scientific reasoning . . ." Applicant does not find this discussion in the record, and the Examiner's mere assertion of this does not make it a fact. In fact, Applicant finds the Examiner's argument, which continues on page 8 of this reply brief, to be a confusing mixture of unrelated concepts. In the single paragraph at the top of this page, the Examiner refers to identifying all the elements of Applicant's claim, a motivation to make the combination, and an assertion that the *prima-facie* case of obviousness has been established. Nowhere in the Examiner's discourse, is there a specific example given, nor has the Examiner provided with any evidence, logic, or reasoning in support of his assertions or that addresses the specific allegations of error made by Applicant in its brief.

While the Examiner, at the bottom of page 8, acknowledges that "the motivation or suggestion to make a modification must be articulated," the Examiner does not point out just where or what this is. Nowhere in the art of record is there a teaching or suggestion that would show motivation, and the Examiner has not pointed to any reason why a person skilled in the art would be so motivated. It appears that the Examiner is taking Official Notice that a person skilled in the art would be motivated to combine the references as stated by the Examiner. However, the Examiner has not stated as much, nor has the Examiner previously addressed the issue of motivation in any way that would indicate he has performed a reasoned and meaningful analysis in this regard. Thus, the Examiner has failed, both in the prosecution and in his answer to address motivation.

Applicant also notes that the Examiner has not provided any support for his arguments that the references sufficiently teach each every element of the claimed invention, nor has the Examiner addressed the specific points raised by the Applicant in its brief.

On page 9, the Examiner erroneously and disparagingly maintains that Applicant has ignored the mandate of numerous court decisions. Applicant has done nothing of the sort. Applicant has carefully cited cases in support of all positions taken. However, there is a huge gap in the teachings of the references and the position taken by the Examiner as to what such references teach. The Examiner must provide credible evidence that a person skilled in the art would be able to fill in that gap without undue experimentation. Here, the Examiner has made conclusionary statements as to what a person skilled in the art might or might not do without providing any basis for such statement. Again, this seems to amount to Official Notice being taken by the Examiner without a formal declaration thereof. Further, had the Examiner made a declaration that he was taking Official Notice, then the Examiner

would be obligated to provide some evidentiary support for this basis, which the Examiner has not done.

While the Examiner quotes with Applicant's approval the decision in *In re Keller*, the Examiner incorrectly applies this precedent. For example, the Examiner states that "the teachings of Chisholm and Marsh, when considered with the knowledge that is generally available to one of ordinary skill in the art make obvious limitation that Applicant disputes." In this regard, the Examiner appears to be bringing a third reference into his rejection, that is what the person skilled in the art knows. However, this is not the standard properly applied. The Examiner is instructed by the MPEP (2143.03) that all limitations must be taught or suggested. This does not mean that the Examiner can make up for gaps in his analysis by stating that elements missing from such combination of references by claiming the missing elements are known by those skilled in the art. Each and every element of Applicant's claimed invention must be found in the art of record. Here, the Examiner appears to be tacitly acknowledging that his analysis with regard to Chisholm and Marsh is flawed and that he must make up the difference by looking to what one of ordinary skill in the art would otherwise understand. While ordinary skill might be used to support a suggestion that the Examiner has properly combined the references, such ordinary skill cannot make up for lack of teaching of specific claim elements in the references.

Here, as noted by Applicant in prosecution of this application and in its brief, the combination of Chisholm and Marsh is fatally defective in teaching each and every element of the claimed invention. The Examiner has said nothing to counter this other than to say he disagrees. Where is his analysis or citations of examples in support of his position? On page 10, the Examiner notes that he has relied on Chisholm as teaching "a rule engine" which the Examiner acknowledges is really a "voter administrator program." The Examiner also

indicates that a business object in Chisholm is really a "voter." The board is referred to Appellant's arguments during prosecution and in its brief. A voting system involving human voters is not the same thing as a business object and rules engine system. Such conclusion is nonsensical. The fact that the word "voter," appears in two unrelated contexts does not mean that it has the same meaning in each context. While the Examiner must give claim terms their broadest meaning, it is improper to give such terms new meanings.

On page 11, the Examiner relies on Marsh as teaching "evaluating a relationship objects with no prior association and uses business rules . . ." (sic). The Examiner has submitted that Marsh suggests an approach to solving a problem. Which problem? Marsh is unrelated to the subject matter and has nothing to do with the teachings of the primary reference, Chisholm. Marsh suggests nothing in connection with the invention, except with the application of hindsight, as is the case here.

On page 11, the Examiner erroneously indicates that "Appellant does not provide anything in the claims or the specifications that requires "voter" to be a machine, element, *per se*." Applicant refers the Board, as Applicant had Examiner, to Claim 1, which recites that a process is taught "in a computer environment." Applicant further teaches that "each business object is a voter." Human beings are not business objects and do not operate in a computer environment. Clearly, Applicant has unambiguously claimed a machine and not a human being. It is erroneous for the Examiner to ignore the plain meaning of Applicant's language, and it is erroneous that the Examiner apply art relating to human interaction to a machine-operated invention, such as that which is clearly claimed herein.

Finally, Applicant notes that a further requirement for a *prima-facie* showing of obviousness is that of likelihood of success of the proposed combination. The

Examiner has at no point addressed this issue. Thus, even if the Examiner were correct with regard to all of the claim elements being present in the reference and the motivation to combine them, the Examiner's showing is incomplete for a lack of showing a likelihood of success in making the combination. Applicant is of the opinion that the references are so unrelated that one could not successfully combine them without undo experimentation, which in itself would amount to an invention.

Respectfully Submitted,



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